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10/701,496	11/06/2003	Yutaka Tosaki	Q78309	7626
65565	7590	01/26/2010		
SUGHRUE-265550 2100 PENNSYLVANIA AVE. NW WASHINGTON, DC 20037-3213			EXAMINER DESAI, ANISH P	
			ART UNIT 1794	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

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USPTO@SUGHRUE.COM
PPROCESSING@SUGHRUE.COM

1. **Continuation of Box 5:**

2. In view of applicant's amendment, the 35 USC Section 112-first paragraph rejections to claims 1-7 are withdrawn.

3. **Continuation of Box 11:**

4. As to applicant's arguments that while Imamura discloses 0.1 to 30 wt% of hydrophilic polymer, there is no description in Imamura as to what this amount is based upon (see page 6 of the amendment), the Examiner submits following:

5. One of ordinary skill in the art in possession of Imamura would recognize that the amount of hydrophilic polymer as taught by Imamura is based on the PSA, given that Imamura states "Any of these hydrophilic polymer particles is added preferably...in consideration of suitable adhesive strength..." Accordingly, applicant's arguments are not found persuasive.

6. Applicant points to Examples of Imamura (see pages 6-7 of the amendment) and asserts that "Although NVP is hydrophilic monomer, since it is copolymerized with other monomers, hydrophilic polymer is no longer generated."

7. The Examiner submits that applicant's arguments are not commensurate in scope with the basis of the rejection. Specifically, the Examiner is not relying on the

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teaching of copolymerization (i.e. copolymer of NVP with other monomers as asserted by applicant) to render obvious claim limitation of hydrophilic polymer; instead the teaching of Imamura at column 6 lines 20-30, where Imamura discloses to add hydrophilic polymer particles is relied upon to render obvious the aforementioned claim limitation. Accordingly, applicant's arguments are not found persuasive.

8. As to applicant's arguments relating to solution polymerization and emulsion polymerization (see pages 7-8 of the amendment), the Examiner respectfully submits that claims are directed to PSA tape (article) as such said arguments are not commensurate in scope with the claimed invention. Further, the Examiner notes that while Imamura discloses solution polymerization, the reference of Imamura also discloses emulsion polymerization (see column 6 line 56).

9. As to applicant's arguments that Imamura does not disclose emulsifier as presently claimed, the Examiner submits that while Imamura do not disclose all of the claim limitation, Imamura is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely hydrophilic polymer as presently claimed, and in combination with the primary reference, discloses the presently claimed invention.

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10. With respect to applicant's arguments "The amount of the anionic emulsifier containing a sulfur atom in a surface portion of the pressure-sensitive adhesive layer, which is one of the main feature of the present invention, is not taught by any of the cited references..." (page 8 of the amendment), the Examiner submits following;

11. As set forth on page 4, paragraph 8 of 07/09/09 Office action, with respect to the claim requirement of concentration of the surfactant, it is noted that since claim language is open to the presence of a surfactant in the entire layer, a concentration gradient of surfactant in the PSA is not required. Thus, a PSA layer having a weight% of the surfactant as claimed by applicant can be interpreted to meet applicant's claimed requirement of the amount of anionic emulsifier containing sulfur atom in a surface portion as presently claimed. As set forth on page 5, paragraph 11 of 07/09/09 Office action, the prior art of Coopridier (US 5,571,617) is relied upon to render obvious the aforementioned claim requirement. Accordingly, applicant's arguments are not found persuasive.

12. As to applicant's arguments "In addition, Imamura describes adding hydrophilic polymer as particle...In this regard, when hydrophilic polymer is added in aqueous system...according to the present invention, the hydrophilic polymer is not in the form of particles" (see page 9 of the amendment), the Examiner submits following:

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13. As set forth on pages 7-8, paragraph 18 of 07/09/09 Office action, claim limitation “wherein the hydrophilic polymer is added as an aqueous solution after the polymerization of the acrylic polymer” is interpreted as product-by-process limitation. There appears to be no structural and/or performance (e.g. adhesive strength) difference between the FINAL article of the prior art and that of applicant by adding the hydrophilic polymer as particles. It appears that applicant has not provided any arguments against the Examiner’s product-by-process rationale. Applicant’s arguments may be persuasive, if applicant can show on the record (e.g. suitable affidavit/declaration) that there would clearly be structural and/or performance difference as a result of addition of hydrophilic polymer of Imamura as particle; instead of aqueous solution as claimed. As set forth in MPEP 716.02(g), “the reason for requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001”.

/A. D./

Examiner, Art Unit 1794

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1794